

REMARKS/ARGUMENTS

The Office Action of July 22, 2004 has been carefully reviewed and this paper is the Applicants' further response thereto. The Applicants respectfully request reconsideration of the Application in view of the foregoing Amendments and the following Remarks.

Claims 1-49 and 51-59 are pending. Claims 2, 3, 12, 14-17, 25-28, 30-34, 41, 42, 44-49, 51-59 were deemed allowable. Claims 1, 5-11, 13, 18-24, 29, 35-40, and 43 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,083,350 to Sandreid *et al.* ("Sandreid"). Claim 4 was objected to as depending from a rejected claim but was deemed allowable if rewritten in independent form.

Initially, the Applicant would like to express gratitude for the indication of additional allowable subject matter. The Applicant's response to the remaining issues is found below.

Objection to a Claim Depending From a Rejected Claim

Claim 4 was objected to as depending from a rejected claim but was deemed allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claim 4 has been amended to include most of the limitations of claim 1 and is believed to be in condition for allowance. Confirmation of same is respectfully requested.

Rejection Under 35 U.S.C § 102(b) - Sandreid

Independent claims 1, 13, and 29 were rejected under 35 U.S.C. §102(b) as being anticipated by Sandreid. As previously noted, claims 1, 13, and 29 have been amended to recite "a coupling surface adaptive to interface with a tensioning tool."

Sandreid discloses a gripping device for clamping on a rope 20, including an arm 22, a jaw member 17, and a handle 31 for moving the jaw member to engage the rope 20. (Sandreid, Col. 4, Ln. 32 – Col. 5, Ln. 7). The Office Action alleged that Sandreid discloses a clamping surface 21. Regarding the element 21, Sandreid explains:

A rope, a cord, or wire 20 to be gripped and locked by the locking device may be passed through a pair of guide rings 21, which are mounted in the frame 10...

(Sandreid, Col. 4, Ln. 43-44). Thus, in operation, a rope passes through the rope passageway in frame 11 and frame 10 via a guide ring 21 (shown as located on both ends of the gripping device in Figure 1) so the rope can be engaged by the engaging surfaces 18 and 19. (Sandreid, Col. 5, Ln. 42-45). The Applicant has reviewed the Sandreid reference and has been unable to locate any discussion of any other use of the guide rings 21. Importantly, there is no suggestion that the guide rings 21 would be suitable to act as “a coupling surface adaptive to interface with a tensioning tool.”

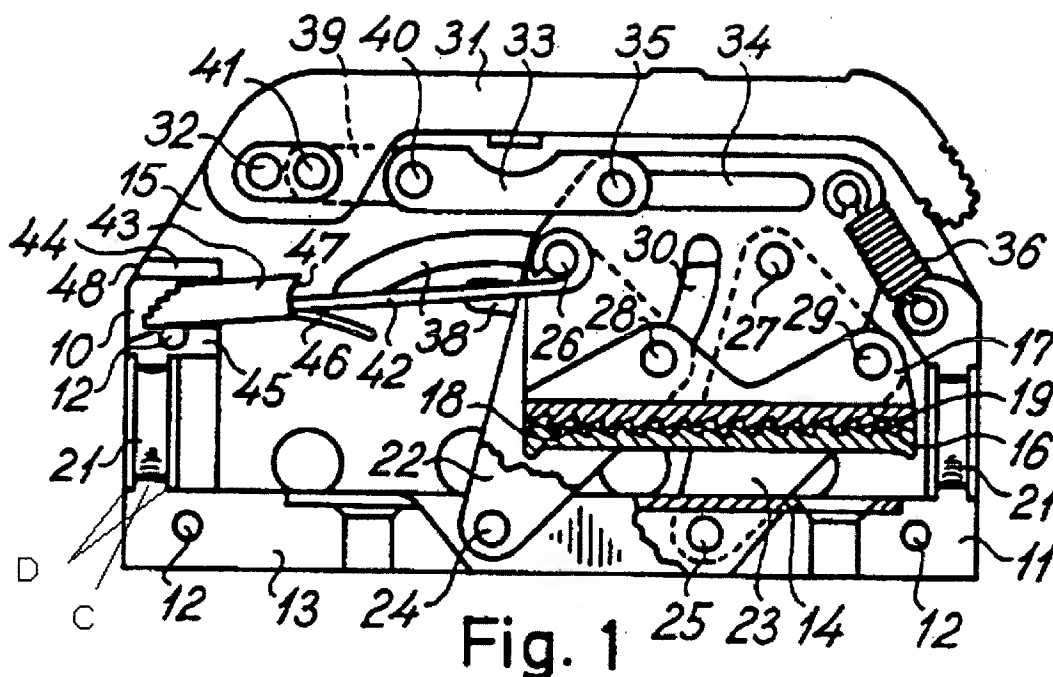
The Office Action, while not disagreeing with the above comments, provides the following reasoning for why the rejection has not been withdrawn:

The Examiner asserts all that is required to meet the limitations “a coupling surface adaptive to interface with a tensioning tool” is a surface onto which a tensioning tool may be clamped. Rings 21 of Sandried et al. include concave external surfaces C which would allow for coupling of a tensioning device.

The Office Action appears to be asserting that Sandried inherently includes the “coupling surface adaptive to interface with a tensioning tool” and thus inherently anticipates the rejected claims because the rejected claims are not structurally distinguishable from Sandried as required in MPEP 2114. In other words, the Office Action seems to be suggesting that as long as Sandried has an external surface, Sandried inherently anticipates “a coupling surface adaptive to interface with a tensioning tool.”

The Applicants agree that it is possible for a reference to inherently anticipate a claim, however, the reference must still enable the claim. The mere fact that Sandried includes an external surface does not mean that the included surface is “a coupling surface adaptive to interface with a tensioning tool.” Thus, the Office Action’s assertion that a surface (i.e. any surface) is sufficient seems unsupported.

The Applicants have again reviewed the Sandried reference and respectfully assert that guide rings 21 do not appear to be capable of use as “a coupling surface adaptive to interface with a tensioning tool” as recited in claim 1, for instance. For example, in representative Figure 1, shown below, the guide rings 21 have flanges D that would prevent any attempt to couple to the external surface C of guide ring 21.



Presently the Office Action does not provide a convincing line of reasoning as to why the guide ring 21 of Sandried would inherently anticipate claim 1, for instance. If the Applicants point is not accepted on this matter, the Examiner is requested to provide a declaration explaining how the guide ring 21 of Sandried would function as “a coupling surface adaptive to interface with a tensioning tool” as recited in claim 1 and why a person of ordinary skill in the art would have recognized Sandried as disclosing such at the time Sandried issued pursuant to MPEP 707 (*see* 37 CFR §1.104(d)(2)) and *Rosco, Inc. v Mirror Lite Co.*, 304 F.3d 1373,1380 (Fed. Cir. 2002) (requiring the missing element to be “necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”).

Otherwise, the Applicants respectfully submit that Sandreid fails to disclose at least one limitation of claims 1, 13 or 29. As Sandreid does not disclose at least every limitation of claims 1, 13 or 29, Sandreid cannot anticipate claims 1, 13 or 29 or the claims depending therefrom. Withdrawal of this rejection is respectfully requested.

Appln. No.: 09/994,088
Amendment dated December 22, 2004
Reply to Office Action mailed July 22, 2004

Consequently, it is respectfully submitted that all the independent claims are in allowable condition and that all claims depending from these independent claims are allowable for the same reasons and for the additional limitations recited in those claims.

CONCLUSION

The Commissioner is hereby authorized to charge any fees in connection with the filing of this Amendment and Response or credit any overpayment of fees to our Deposit Account No 19-0733.

All rejections and objections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: December 22, 2004

By:



Binal J. Patel
Registration No. 42,065

Banner & Witcoff, LTD.
Ten South Wacker Drive
Chicago, Illinois 60606
Tel: (312) 463-5000
Fax: (312) 463-5001